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| EXAMINER | |
|---|---|
| VO, CECILE H | |

| ART UNIT | PAPER NUMBER |
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| 2169 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/583,273 | YOSHIKAWA, TADASHI | |
| | Examiner | Art Unit | |
| | CECILE VO | 2169 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *04 February 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/24/2009 has been entered.

2. Claims 1-26 are pending as amended on 02/24/2009, with claims 1, 2, 7, 12, 13, 14, 15, 20, 25 and 26 being independent. Claims 1, 2, 7, 12, 13, 14, 15, 20, 25 and 26 are currently amended.

3. Applicant's arguments to rejection of claims 20-24 under 35 U.S.C 101 is acknowledged. However, examiner is not persuaded.

As per Applicant's assertion that "*claim 20 relates to an "information transmitter"; a digital camera 2 as the information transmitter of the present invention". A "digital camera" and "cellular phone" are apparently machines of manufacture" that are included in one of the four categories of invention*", the examiner respectfully disagrees. It is noted the claim is directed to a machine only if at least one of the claimed elements of the system is a physical part of a device can the system as claimed constitute part of a device or a combination of devices to be a machine within the meaning of 101. In this case, there is

no explicit definition in the claims that the machine limits to a combination of hardware and software. Thus, claims 20-24 are non-statutory.

Therefore, the examiner maintains the rejection to the claims.

4. New grounds of rejection are provided based on the amendments.

### *Claim Rejections - 35 USC § 101*

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 20-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 20-24 are directed to a system comprising software per se. Software per se is not one of the four categories of invention. Software per se is not a series of steps or acts and thus is not a process. Software per se is not a physical article or object and as such is not a machine of manufacture. Software per se is not a combination of substances and thus, is not a composition of matter.

### *Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-3, 5-16 and 18-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Irie, Publication Number US 2003/0122943.

Regarding claim 1, Irie discloses a data storage device having a storage means for storing acquired data in a hierarchical structure, comprising:

an image pickup unit for picking up an image (e.g. an image-pickup apparatus includes an image-pickup means for taking a picture of an object to obtain image data of the object, §0031, lines 1-3);

an extraction means for extracting a piece of code information corresponding to a code which is possessed on said image from a piece of image data acquired by picking up an image by the image pickup unit (e.g. when the user inputs a desired filename of

tune or sound by operating the operation switch, the tune code or the sound code is determined from the filename input by the user, §0098, lines 5-8); and

a name generation means for generating a folder name or a file name relating to the piece of image data based on the piece of code information extracted by the extraction means (e.g. the file of the pickup image is named "tune code+serial number" or "sound code+serial number" using the tune code or the sound code determined. In other words, if a first image in JPEG format is taken with the tune code "005B" selected, then the file of the first image is named "005B0001.JPG", and the file of a fifth image is named "005B0005.JPG", §0103, lines 5-8).

Regarding claim 2, Irie discloses a data storage device having a storage means for storing acquired data in a hierarchical structure, comprising:

an image pickup unit for picking up an image (e.g. an image-pickup apparatus includes an image-pickup means for taking a picture of an object to obtain image data of the object, §0031, lines 1-3);

a code recognition unit having a table in which pieces of code information is respectively corresponded to a plurality of pieces of image data (e.g. Figure 12);

an extraction means for extracting a piece of the code information to a code which is possessed on said image, from the table, corresponding to a piece of the image data acquired by picking up an image by the image pickup unit (e.g. when the user inputs a desired filename of tune or sound by operating the operation switch, the

tune code or the sound code is determined from the filename input by the user, §0098, lines 5-8); and

a name generation means for generating a folder name or a file name relating to the piece of the image data based on the piece of the code information extracted by the extraction means (e.g. Filenames of image files in Figure 14. Wherein, the file of the pickup image is named "tune code+serial number" or "sound code+serial number" using the tune code or the sound code determined. In other words, if a first image in JPEG format is taken with the tune code "005B" selected, then the file of the first image is named "005B0001.JPG", and the file of a fifth image is named "005B0005.JPG", §0103, lines 5-8).

Regarding claim 3, Irie discloses the data storage device, further comprising a determination means for determining whether or not the piece of the code information is extracted by the extraction means, wherein when the determination means determines that the piece of the code information is not extracted by the extraction means (e.g. it is judged which filename is selected, §0098), the name generation means generates the folder name or the file name relating to the piece of the image data based on predetermined information (§0103, lines 5-8).

Regarding claim 5, Irie discloses the data storage device, further comprising:

a folder generation means for generating in the storage means a folder of the folder name generated by the name generation means ( e.g. the image data held in the

DRAM 205 is stored in the flash memory 204 with the filename determined at Step S103, §0103, lines 7-9) ; and

a name changing means for changing the folder name or the file name relating to data stored in the storage means, to the folder name or the file name generated by the name generation means (e.g. the filename determined at Step S109 is just required to include first eight characters respectively corresponding to image files, and the serial number included in the filename may be intermittent or continuous in the order in which images are taken in, §0104, lines 1-5).

Regarding claim 6, Irie discloses the data storage device, further comprising a reception means for receiving a selection of a first or second processing, wherein when the reception means receives the selection of the first processing, the folder generation means generates in the storage means the folder of the folder name generated by the name generation means, and when the reception means receives the selection of the second processing, the name changing means changes the folder name or the file name relating to the data stored in the storage means, to the folder name or the file name generated by the name generation means (e.g. when the camera receives the photographing conditions selected , camera control is exercised to adjust the optical mechanism to meet the photographing conditions, §0101, lines 1-4).

Regarding claim 7, Irie discloses an information transmitter that transmits information to outside, comprising:

an image pickup unit for picking up an image (e.g. an image-pickup apparatus includes an image-pickup means for taking a picture of an object to obtain image data of the object, §0031, lines 1-3);

a code acquisition means for acquiring a code which is possessed on said image from a piece of image data obtained by picking up an image by the image pickup unit (e.g. The photographing condition defines condition on which a picture is taken to obtain image data., §0097, lines 12-14);

an analyzing means for analyzing the code acquired by the code acquisition means and acquires a piece of code information corresponding to a code acquired by the code acquisition means (e.g. It is judged which filename is selected, §0098); and

a transmission means for transmitting to outside the piece of code information acquired by the analyzing means (e.g. When the tune code or the sound code is determined, the sound source section 4 is instructed to give a demonstration of outputting the tune or the sound based on the code determined. When it is judged that a predetermined time has lapsed; YES, the sound source section 4 is instructed to cease the demonstration, §0099).

Regarding claim 8, Irie discloses the information transmitter, further comprising:

a display means for displaying the piece of code information acquired by the analyzing means (e.g. The image output circuit 206 is for converting the image data held in the DRAM 205 to a video signal, and is connected to LCD 207 for displaying an

image based on the video signal and to a video output terminal 208 for outputting the video signal, §0088, lines 4-8); and

an instruction reception means for receiving an instruction whether or not the piece of code information displayed on the display means is transmitted, wherein the transmission means transmits the piece of code information when an instruction to transmit the piece of code information is received by the instruction reception means (e.g. reproducing means for reproducing an image based on the image data identified by the image-data identifying data stored in the identifying-data storing means and for outputting sound based on the sound data identified by the sound-data identifying data stored in the identifying-data storing means, §0031, lines 17-22).

Regarding claim 9, Irie discloses the information transmitter, further comprising an encoding means for encoding the piece of code information acquired by the analyzing means, wherein the transmission means sends the piece of code information encoded by the encoding means (e.g. the image output circuit is for converting the image data held in the DRAM to a video signal, and is connected to LCD for displaying an image based on the video signal and to a video output terminal for outputting the video signal, §0088, lines 4-8).

Regarding claim 10, Irie discloses the information transmitter, further comprising:

a plurality of analyzing means respectively corresponding to different codes (§0098); and

a selection means for selecting, based on the code acquired by the code acquisition means, an analyzing means to analyze the code from the plurality of analyzing means (§0037, lines 16-18), wherein

the analyzing means selected by the selection means analyzes the code acquired by the code acquisition means (§0098).

Regarding claim 11, Irie discloses the information transmitter, further comprising a storage means for storing the code acquired by the code acquisition means and the piece of code information acquired by analyzing the code by the analyzing means, for each analyzing means selected by the selection means (§0033).

Regarding claim 12, Irie discloses a data storage system, comprising:

an information transmitter that transmits information to outside (e.g. digital camera, §0087, lines 1-2), comprising:

an image pickup unit for picking up an image (e.g. an image-pickup apparatus includes an image-pickup means for taking a picture of an object to obtain image data of the object, §0031, lines 1-3);

a code acquisition means for acquiring a code which is possessed on said image from a piece of image data obtained by picking up an image by the image pickup unit (e.g. the photographing condition defines condition on which a picture is taken to obtain image data., §0097, lines 12-14);

an analyzing means for analyzing the code acquired by the code acquisition means and acquires a piece of code information corresponding to a code acquired by the code acquisition means (e.g. It is judged which filename is selected, §0098); and

a transmission means for transmitting to outside the piece of code information acquired by the analyzing means (e.g. When the tune code or the sound code is determined, the sound source section 4 is instructed to give a demonstration of outputting the tune or the sound based on the code determined. When it is judged that a predetermined time has lapsed; YES, the sound source section 4 is instructed to cease the demonstration, §0099); and

a data storage device for storing data in a hierarchical structure, the data storage device comprising:

a reception means for receiving the piece of code information transmitted from the information transmitter (§0031, lines 17-22); and

a name generation means for generating a folder name or a file name relating to the data, based on the piece of code information received by the reception means (§0103, lines 5-8).

Regarding claim 13, Irie discloses an information processing system, comprising:

an information transmitter that transmits information to outside (e.g. digital camera, §0087, lines 1-2), comprising:

an image pickup unit for picking up an image (e.g. an image-pickup apparatus includes an image-pickup means for taking a picture of an object to obtain image data of the object, §0031, lines 1-3);

a code acquisition means for acquiring a code which is possessed on said image from a piece of image data obtained by picking up an image by the image pickup unit (§0097, lines 12-14);

an analyzing means for analyzing the code acquired by the code acquisition means and acquires a piece of code information corresponding to a code acquired by the code acquisition means (§0098); and

a transmission means for transmitting to outside the piece of code information acquired by the analyzing means (§0099); and

an information processor for performing a predetermined processing based on the piece of code information transmitted from the information transmitter (e.g. the camera section3 is provided with CPU, §0087, line 4).

Claims 14-19 are similar to claims 1-6; therefore, claims 14-19 are rejected by the same reasons as discussed above.

Regarding claim 20, Irie discloses an information transmitter that transmits information to outside, comprising:

an image pickup unit for picking up an image (e.g. an image-pickup apparatus includes an image-pickup means for taking a picture of an object to obtain image data of the object, §0031, lines 1-3);

a code extraction unit for acquiring a code which is possessed on said image from a piece of image data obtained by picking up an image by the image pickup unit (§0098);

a decoding unit for analyzing the code thus acquired and acquires a piece of code information corresponding to a code acquired by the code extraction unit (e.g. image-reproducing means for reading out from the second storing means the image data represented by the image-file name selected by the second selecting means, and for reproducing an image based on the read out image data, detecting means for detecting a tune code used in the image filename selected by the second selecting means, and tune-reproducing means for reading out from the first storing means the MIDI data of the tune represented by the tune code detected by the detecting means, and reproducing the tune based on the read out MIDI data, §0037, lines 18-28); and

a communication unit for transmitting the acquired piece of code information to outside (e.g. the image output circuit is for converting the image data held in the DRAM to a video signal, and is connected to LCD for displaying an image based on the video signal and to a video output terminal for outputting the video signal, §0088, lines 4-8).

Regarding claim 21, Irie discloses the information transmitter, further comprising:

a display unit for displaying the acquired piece of code information (e.g. LCD, §0088, line 6); and

an operation unit for receiving an instruction whether or not the displayed piece of code information is transmitted (§0088, lines 8-14), wherein

the communication unit transmits the piece of code information when an instruction to transmit the piece of code information is received (e.g. a video output terminal, §0088, lines 4-8).

Regarding claim 22, Irie discloses the information transmitter, further comprising a controller capable of encoding the acquired piece of code information (§0088, lines 4-8), wherein

the communication unit transmits the encoded piece of code information (e.g. a video output terminal, §0088, lines 4-8).

Regarding claim 23, Irie discloses the information transmitter, wherein

the decoding unit includes a plurality of decoders respectively corresponding to different codes, for analyzing the acquired code to acquire the piece of code information (§0037, lines 18-28), and

the information transmitter further comprises a decoder selection unit for selecting, based on the code acquired by the code extraction unit (§0037, lines 4-7), a decoder to analyze the code from the plurality of decoders (§0037, lines 18-28), wherein

the decoder selected by the decoder selection unit analyzes the code acquired by the code extraction unit (§0037, lines 18-28).

Regarding claim 24, Irie discloses the information transmitter, further comprising a controller capable of storing the code acquired by the code extraction unit and the piece of code information obtained by analyzing the acquired code, for each decoder selected by the decoder selection unit (e.g. identifying-data storing, §0031, lines 11-17).

Claims 25-26 are similar to claims 12-13; therefore, claims 25-26 are rejected by the same reasons as discussed above.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Irie, Publication Number US 2003/0122943 above, and further in view of Hatanaka, US Patent Number 6,438,320 B1.

Regarding claims 4 and 17, Irie does not explicitly discloses:

reporting a message that the piece of code information is not extracted, when determining accordingly.

Hatanaka teaches: the file structure in the memory area of the card is examined and a check is made to see if the file of the file name exists in the route directory. If the file of such a file name exists, since the director of the same name cannot be formed, and a message to notify the user of the reason id displayed on a display apparatus (Hatanaka: col. 6, lines 1-7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify method of storing and reproducing data in an image-pickup apparatus discloses by Irie to include reporting a message as shown by Hatanaka in order to manage the file structure of a storage device.

## ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CECILE VO whose telephone number is (571)270-3031. The examiner can normally be reached on Mon - Thu (9AM - 5:00PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tony Mahmoudi can be reached on 571-272-4078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

March 26, 2009
/Cam Y Truong/
Primary Examiner, Art Unit 2169

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Examiner
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